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APPLICATION NUMBER	FILING DATE	FIRST NAMED APPLICANT	ATTY. DOCKET NO.
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09/322,174 05/28/99 LANDA

B UCT-A

EXAMINER

IM22/0227

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COWAN, LIEBOWITZ AND LATMAN, P.C.
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NEW YORK NY 10036-6799

GOODSON, J	PAPER NUMBER
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1753

DATE MAILED: 02/27/01

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

OFFICE ACTION SUMMARY

- ☐ Responsive to communication(s) filed on _____
- ☐ This action is **FINAL**.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 D.C. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

- ☒ Claim(s) 54-76 is/are pending in the application.
- ☐ Of the above, claim(s) 59, 60, 64, 68, 72, 76 is/are withdrawn from consideration.
- ☐ Claim(s) _____ is/are allowed.
- ☒ Claim(s) 54-58, 61-63, 65-67, 69-71, 73-75 is/are rejected.
- ☐ Claim(s) _____ is/are objected to.
- ☐ Claim(s) _____ are subject to restriction or election requirement.

Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- ☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
- ☐ received.
- ☐ received in Application No. (Series Code/Serial Number) _____
- ☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

- ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- ☐ Notice of Reference Cited, PTO-892
- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____
- ☐ Interview Summary, PTO-413
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Notice of Informal Patent Application, PTO-152

—SEE OFFICE ACTION ON THE FOLLOWING PAGES—

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1. Claims 54-58, 61-63, 65-67, 69-71 and 73-75 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Chow et al. '362 in view of Ray et al. Applicant's arguments have been carefully considered but are not deemed persuasive in view of the following. Applicant's correction of the numbering of the claims in his remarks appears to be correct. The original presentation of claims 1-52 had two claims numbered 51. It appears that applicant's intention was to cancel claims 1-53 in a preliminary amendment and enter new claims 54-76 and presented such claims numbered in the election with traverse, Paper No. 6. Claim 67 dependent on claim 58 and claim 76 dependent upon claim 72 have been corrected. The restriction requirement has been reviewed and deemed distinct in that there are two inventions that are classified in different subclasses and have unrelated areas for possible search other than the areas where they are classified. Chow et al. '362 teaches a metallic toner that can be utilized with standard electrophotographic equipment (note column 13 lines 1-15). The various metals utilized can be silver and gold (note column 4 lines 40-50) that can contain surfactants or a synthetic polymer or copolymer (note column 6 lines 40-50). Ray et al. is adequately shown in Paper No. 11. It would have been obvious to one of ordinary skill in the art at the time of applicant's invention with a reasonable expectation of success to utilize the metal flakes in the preparation of a toner as shown

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in Chow et al. where a metallic toner is utilized in a fluid composition for developing latent electrostatic images. Applicant argues on page 2 of his response that "actually containing flakes results in a much larger particle than usually used in liquid toner". Applicant should show in the specification how such larger particles are providing unexpected results in the use of the liquid toner.

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February 26, 2001


JOHN GOODROW
PRIMARY EXAMINER
ART UNIT 157